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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,680	07/20/2001	James B. Schrempp	5219P005	2531

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EXAMINER

PATEL, DHAIRYA A

ART UNIT	PAPER NUMBER
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2451

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: JAMES B. SCHREMPP, VANCE IKEZOYE, ERLING H.
WOLD, THOMAS L. BLUM, DOUGLAS F. KEISLAR and JAMES A.
WHEATON

Application No. 09/910,680
Technology Center 2400

Mailed: August 4, 2009

Before Quita Gould *Supervisory Paralegal Specialist*
Gould, *Supervisory Paralegal Specialist*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on September 30, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

INFORMATION DISCLOSURE STATEMENT

Appellant filed an Information Disclosure Statement (IDS) dated May 7, 2007. There is no indication on the record that the Examiner has considered the above Information Disclosure Statement. MPEP § 609 requires the Examiner to consider any Information Disclosure Statement filed by Applicant if timely submitted. A written communication notifying Appellant of the Examiner's consideration of the above Information Disclosure Statement is required.

EXAMINER'S ANSWER

Grounds of Rejection to be Reviewed on Appeal

A review of the file finds that the grounds of rejection to be reviewed on appeal of the claims as provided in the Examiner's Answer mailed December 5, 2007, under the heading "Grounds of Rejection to be Reviewed on Appeal" are not consistent with the grounds of rejection of claims set forth in the last Office Action of record, including any Advisory Actions responsive to any after final submissions. Each ground of rejection to be reviewed on appeal must be identified.

Specifically, the Examiner's Answer does not set forth the rejection of claim 29 under 103(a) as unpatentable over Lert1 and Chowdhury in further view of Brouwer or the rejection of claim 35 under 103(a) as unpatentable over Lert1 in view of Brouwer in the Grounds of Rejection to be Reviewed on Appeal; whereas the last Office Action, including any mailed Advisory Action(s) states the above rejections.

Furthermore, the Examiner must provide a clear statement of whether Examiner agrees or disagrees with the statement of grounds of rejection to be reviewed on appeal as set forth in the Brief and an explanation of any

disagreement. *See also Manual of Patent Examining Procedure* (MPEP) § 1207.02 (8th ed. Rev. 6, Sept 2007) for details.

A review of the Examiner's Answer finds that the Examiner's Answer does not clearly address differences between rejections set forth in the Examiner's Answer and those addressed in the Brief.

Clarification of the record is required for all Grounds of Rejection to be Reviewed on Appeal for all claims.

Evidence Relied Upon

Section 1207.02 of the *Manual of Patent Examining Procedure* (MPEP) (Eighth Edition, Rev. 6, September 2007) states:

(A) CONTENT REQUIREMENTS FOR EXAMINER'S ANSWER. The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

....

(8) Evidence Relied Upon. A listing of the evidence relied on (e.g., patents, publications, admitted prior art), and in the case of nonpatent references, the relevant page or pages.

The Examiner's Answer mailed December 5, 2007, is deficient because the "Evidence Relied Upon" section fails to cite the reference Brouwer et al. (USPN 6,279,124). This reference is cited in the Examiner's grounds of rejection of claims 29 and 35 under 35 U.S.C. § 103(a) on page 23. Correction is required and may be made on a Form PTO-90.

CONCLUSION

Accordingly, it is ORDERED that the application is returned to the Examiner to:

Application No. 09/910,680

- 1) consider the Information Disclosure Statement filed May 7, 2007;
- 2) issue a Form PTO-90 to correct the “Grounds of Rejection to be Reviewed on Appeal”, “Evidence Relied Upon”, and any other sections of the Examiner’s Answer, mailed December 5, 2007, as necessary; and
- 3) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

QSG/saw

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